

Application Serial No. 10/686,321
Amendment A
Reply to Office Action of September 12, 2005

REMARKS/ARGUMENTS

This paper is being submitted in response to the Non-Final Office Action dated September 12, 2005, having a shortened statutory period set to expire December 12, 2005, wherein:

Claims 1-20 were previously pending; and

Claims 1-20 were rejected.

Claims 1-20 have been amended and no claims have been added or canceled by this amendment. Accordingly, claims 1-20 remain currently pending in the above-identified patent application. Applicants submit that no new matter has been added by this amendment and respectfully request reconsideration of all pending claims in light of the amendments and remarks made herein.

Claim Rejections under 35 U.S.C. § 102

In the present Office Action, claims 1-20 were rejected under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 4,828,257 issued to Dyer, et al (hereinafter "*Dyer*"). While not conceding that any of the Examiner's cited references qualify as prior art but in the interest of expediting prosecution, Applicants have elected to traverse in part and in part overcome the Examiner's rejections as follows. Applicants reserve the right, for example in a continuation application, to establish that one or more of the Examiner's cited references do not qualify as prior art with respect to invention embodiments claimed in the above-identified application.

Applicants' claim 1 as previously submitted recited a system comprising:

means for receiving at said portable computer system at least one indicator of current exercise performed by said particular user from said particular exercise machine in use by said particular user;
means for comparing said at least one indicator of current exercise with fitness goals for said particular user at said portable computer system; and
means for adjusting a control signal transmitted from said portable computer system to said particular exercise machine in order to adjust said movement of said particular exercise machine to aid said particular user in meeting said fitness goals.

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(Applicants' claim 1 as previously-submitted, emphasis supplied). As amended herein, claim 1 includes claim elements substantively similar to those indicated above.

With regard to Applicants' claim 1 as previously-submitted, the Examiner states in the present Office Action that *Dyer* discloses the indicated elements at column 45, line 48 to column 46, line 46. Applicants respectfully disagree.

A *prima facie* case of anticipation under 35 U.S.C. §102 requires "the disclosure in a single prior art reference of each element of the claim under consideration" (*W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)) and further that each and every element is disclosed, "arranged as in the claim" (*Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984)). Thus, to establish a *prima facie* case of anticipation, the Examiner must show not only that *Dyer* teaches means for receiving, comparing, and adjusting as recited in Applicants claim, but that *Dyer* teaches means for receiving at least one indicator of current exercise at a portable computer system, means for comparing, at the portable computer, the at least one indicator of current exercise with fitness goals for a particular user, and means for adjusting a control signal transmitted from the portable computer system in order to adjust a particular exercise machine as specifically claimed by Applicants.

Applicants note that the Examiner is also required, under 37 C.F.R. §1.104(c)(2) to designate the particular part of the reference relied on as nearly as practicable, where, such as the case with *Dyer*, the reference is complex or shows or describes inventions other than that purportedly claimed by Applicants. Applicants respectfully submit that *Dyer* fails to teach one or more of the elements indicated above and that consequently, a *prima facie* case of anticipation has not been established.

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Dyer fails to teach a portable computer system

Dyer teaches an "electronically controlled exercise system" (*Dyer*, Title) and in the Examiner's cited portion, describes flow diagrams (Figs. 39 and 40) illustrating "operation of the system and method" of *Dyer*'s invention. More specifically, in the indicated portion (column 45, line 48 to column 46, line 46) *Dyer* teaches the use of a CPU to update an alphanumeric display (*Dyer*, Fig. 39) and the conditions under which the simulated weight against which a user is exercising is increased and the means by which this increase is accomplished (*Dyer*, Fig. 40). The Examiner's cited portion also teaches determinations made by a CPU "whether the number of repetitions of the exercise which have been performed by the user are greater than the number of repetitions which were previously defined as being needed to complete an exercise set" and whether or not the exercise arm being manipulated by a user is moving in an upward direction or not (*Dyer*, column 45, line 62 - column 46, line 7). *Dyer* further teaches the production of a control signal based upon the indicated determinations "increasing the resistance applied by brake 64 to the movement of the exercise arm" to simulate an increase in weight (*Dyer*, column 46, lines 8-13).

The Examiner's cited portion of *Dyer* fails to indicate however the location of the described CPU, and therefore fails to teach that such a CPU is a component of or otherwise associated with a portable computer system. Rather, at Figs. 1-6 and the accompanying description, *Dyer* teaches a system including a single central computer 150 comprising "a central control device" coupled to an interactive weight lifting station 154 such as the station described in connection with Figs. 1-4 and optionally coupled to each of an interactive printer station 156, an interactive monitor station 158, and/or an interactive aerobic station 155 via a communication link 153. As depicted in Figs. 4 and 6, the interactive weight lifting station 154 of *Dyer*'s teaching includes a communications terminal 130 which includes a processor 160 separate and distinct from central computer 150 and utilized, according to *Dyer*'s teaching to "control a magnetic brake system 176 which functions to control the magnetic brake 64." Nowhere within the Examiner's cited portion does *Dyer* teach, show, or suggest that central computer 150 or communications terminal 132 (which is depicted as being integral with interactive weight lifting station 154) is a "portable computer system" as claimed.

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Because *Dyer*, within the Examiner's cited portions, fails to teach a portable computer system as claimed and no other portion of *Dyer* or any other reference has been cited as teaching, showing or suggesting this element, Applicants respectfully submit that a *prima facie* case of anticipation has not been established in the present Office Action.

For at least the foregoing reasons, Applicants respectfully submit that claim 1, as previously submitted and as amended herein, is allowable in view of the Examiner's cited references. Applicants submit claim 11 (both as previously submitted and amended herein) includes one or more elements substantially similar to those described herein with respect to claim 1 and is therefore allowable for at least the reasons stated with respect to that claim. All remaining claims depend directly or indirectly from Applicants' claims 1 or 11 and are therefore similarly allowable.

CONCLUSION

In light of the amendments and remarks made herein, Applicants submit that all pending claims are allowable and earnestly solicit notice thereof.

No extension of time for this response is believed to be necessary. However, in the event an extension of time is required, that extension of time is hereby requested. Please credit any overpayments and charge any fee associated with an extension of time as well as any other fee necessary to further the prosecution of this application to **IBM CORPORATION DEPOSIT ACCOUNT No. 09-0447**.

Respectfully submitted,



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